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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,831	07/03/2003	Wang Wei Min	03-108	6808
23843	7590	05/02/2007		
FOOTHILL LAW GROUP 777 N. FIRST STREET, SUITE325 SAN JOSE, CA 95112			EXAMINER FELTON, MICHAEL J	
			ART UNIT 1731	PAPER NUMBER
			MAIL DATE 05/02/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/613,831	<b>Applicant(s)</b> MIN, WANG WEI	
	<b>Examiner</b> Michael J. Felton	<b>Art Unit</b> 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

### ***Response to Amendment***

2. The applicant has amended the claims by replacing "comprising" with "consisting essentially of". The MPEP states (2111.03):

If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also Ex parte Hoffman, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989)

Therefore, the applicant must indicate what components are excluded and that the inclusion of such components would materially affect the basic and novel characteristics of the invention.

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. Claim 1, 3-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grasso (US. Pat. No. 3,313,308) in view of Walters (US. Pat. No. 3,196,881) and Mensik (US. Pat. No. 4,517,989).

Regarding claim 1, Grasso teaches an article for smoking an elongate tobacco product comprising:

(a) a mouthpiece having an inside surface and an outside surface, comprising a first end defining a receptacle therein and a second end comprising an outside surface capable of being grasped in a smoker's mouth and defining an outlet chamber within the mouthpiece, wherein the mouthpiece consists of a single piece of molded plastic (Figures 2 and 3); and

(b) a holder, the holder being removably inserted into the receptacle (Figure 2), the holder comprising,

i) a first section disposed at an end of the holder defining an inside chamber capable of holding the elongate tobacco product in place and allowing a volume for collection of combustion products therein, the first section having an outside surface with a diameter too large to fit into the receptacle in the mouth piece (Figure 3),

ii) a second section in series with the first section and having an inside and an outside surface, the second section contoured to fit into the receptacle in the mouthpiece and defining a continuation of the inside chamber (Figure 3 reference number 18),

iii) a first annular support (Figure 3, reference number 48) and a second annular support (Figure 3, reference number 36) on the outside surface of the second section, each annular support being capable of holding a resilient ring thereon,

iv) an annular baffle on the outside of the second section between the first annular support and the second annular support (Figures 2 and 3, reference number 26; column 2, lines 20-21), and

v) one resilient ring supported on one of the annular supports (Figures 2 and 3), wherein the mouthpiece and the holder are contoured such that when the holder is inserted into the mouthpiece the resilient ring is in contact with the inner surface of the mouthpiece forming a sealed chamber in the annular space between the resilient ring and one of the annular supports between the outside surface of the second section and the inside surface of the mouthpiece (Figure 3; 63-65), and wherein the holder defines at least one restricted passage from the inside chamber to the sealed chamber, said at least one restricted passage being directed towards in the inside surface of the mouthpiece between the two annular supports, and wherein the holder further defines an exit passage having at least one inlet between the baffle and the second annular support and an exit into the outlet chamber of the mouthpiece (Figure 3; column 3, lines 39-40).

(e) the holder further comprises a barrier in series with the second inside chamber such that combustion products can only pass between the inside chamber and

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the outlet chamber through a path through the restricted passage, the sealed chamber and the exit passage in sequence (Figure 3; column 3, lines 39-40 and lines 44-46).

Grasso fails to teach two resilient rings, one resilient ring supported on each annular support. Grasso also fails to teach a holder that consists of a single piece of molded plastic. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used two resilient rings one on each annular support and to have constructed the holder of a single piece of material since such is already known in cigarette holders as evidenced by the Walters reference (see fig. 2). Further, one having ordinary skill in the art would have fabricated both the mouthpiece and the holder out of a material, such as plastic, since cigarette mouthpieces and holders are known to be fabricated from plastic as evidenced by the Mensik reference. It would also have been obvious to use two restricted passages as shown by Mensik in figures 1 and 2). Accordingly, claim 1 is rejected.

Regarding claim 3-5, Grasso teaches the holder is for cigarettes and the like (claim 1, line 1). Grasso does not specifically teach the holder is for cigarettes of the type without an integral filter, cigarettes with an integral filter, or for cigars. However, because Grasso fails to limit his teaching to any particular type of cigarette or tobacco product, it would have been obvious to one of ordinary skill in the art at the time of the invention that Grasso's teaching could have been applied to a cigarette with an integral filter, a cigarette without an integral filter, or to a cigar. Accordingly, claims 3-6 are rejected.

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Regarding claim 8, Grasso teaches the holder has symmetry about a central plane, wherein any cross section perpendicular to the central plane is circular (Figure 3; column 2, lines 7-12; column 2, lines 55-56). Accordingly, claim 8 is rejected.

Regarding claim 9, Grasso teaches that at least one restricted passage is perpendicular to the central plane of symmetry whereby combustion products are made to change direction by approximately 90 degrees in passing between the second inside chamber and the sealed chamber (column 3, lines 20-28). Accordingly, claim 9 is rejected.

Regarding claim 11, Grasso teaches that the exit passage causes a change in direction, whereby combustion products are made to change direction by approximately 90 degrees in passing between the sealed chamber and the outlet chamber (Figure 3). Accordingly, claim 11 is rejected.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Felton whose telephone number is 571-272-4805. The examiner can normally be reached on Monday to Friday, 7:30 AM to 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJF

  
STEVEN P. GRIFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700